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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,499	06/19/2001	Jeffrey A. Bedell	53470.003034	8688
21967 7590 01/09/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER RIMELL, SAMUEL G	
			ART UNIT 2164	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/883,499

Applicant(s)

BEDELL ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-12, 14-21 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19, 20, 26, 28 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-18, 21, 27, 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.


SAM RIMELL
PRIMARY EXAMINER

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: Claim 1 calls for the evaluation of a plurality of methods for generating intermediate data sets. This is followed by a query language statement assembled and run against the data source. The claim is unclear since it not clear how the result of the evaluating step is related to the remainder of the claimed invention.

Claims 2-3 and 5-9: Depend on claim 1.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10- 12, 14-18, 21, 27 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 10: The last step of claim 10 is a step of evaluating a plurality of methods, from which no result is produced. Claim 10 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology "computer implemented method" does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claims 11-12 and 14-18: Depend on claim 10.

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Claim 21: The last step of claim 21 is a step of evaluating a plurality of methods, from which no result is produced. Claim 21 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented system” does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claim 27: The last steps of claim 27 involve steps of evaluating a plurality of methods, from which no result is produced. Claim 27 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented method” does not render the claimed invention statutory since the result of the invention is the not computer itself.

Claim 29: The last steps of claim 29 involve steps of evaluating a plurality of methods, from which no result is produced. Claim 29 lacks a useful, concrete and tangible result since no result is produced at all. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). The terminology “computer implemented system” does not render the claimed invention statutory since the result of the invention is the not computer itself.

No prior art is applied. Claims 1-3 and 5-9 would be allowed if amended to overcome the rejections under 35 USC 112, second paragraph. Claims 10-12, 14-18, 21, 27, 29 would be allowed if amended to overcome the rejections under 35 USC 101.

Claims 19-20, 26 and 28 are allowed.

Remarks

Applicant's arguments and amendments have been considered.

Claims 1-3 and 5-12 remain rejected under 35 USC 112, second paragraph. Although claim 1 has been amended, the amendment does not clarify how the result of the evaluation is related to the remaining steps of the claim. The result of the evaluation and assembling of the query appear to be completely unrelated, making it unclear what purpose the evaluation has in the actual invention.

Claims 10, 12, 14-18, 21, 27 and 29 have been rejected under 35 USC 101 because the claimed invention is non-statutory. Claims 10 and 21 have been amended to recite the intended usage "...to return a method for generating intermediate data sets.." Such an amendment does not overcome the rejection under 35 USC 101 because it is merely reciting an intended result, or possible result, rather than an actual result which must be produced by the claimed invention. Independent claims 27 and 29 were not amended, and thus the rejection for these claims are sustained for the reasons previously cited herein. Applicant argues that each of claims 27 and 29 produces a result of a determination. However, the determination is only an intermediate process that may lead to a result, but is not the actual result itself. Additionally, a "determination" *per se* does not meet the requirements for being useful, concrete or tangible.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
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